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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/612,506 | 07/02/2003 | Motoaki Aoyama | KOT-0078 | 3507 |

23413          7590          08/28/2008
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| EXAMINER |
|---|
| NGUYEN, ALLEN H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/28/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/612,506 | AOYAMA ET AL. |
| ***Office Action Summary*** | Examiner | Art Unit | |
| | ALLEN H. NGUYEN | 2625 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *18 June 2008*.

2a) ☐ This action is **FINAL**.          2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-15* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *13 December 2004* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1.      A request for continued examination under 37 CFR 1.114, including the

fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114,

and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the

previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 06/18/2008 has been entered.  Currently, claims

1-15 are pending.


### *Priority*

2.      Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d),

which papers have been placed of record in the file.


### *Response to Arguments*

3.      Applicant's arguments filed 05/19/2008 have been fully considered but

they are not persuasive.


4.      With respect to applicant's argument that "the cited post processing of

Okimoto is not a physical treatment that physically changes an appearance

and/or a binding mode of said print product and Okimoto also do not teach or

suggest any type of post processing that physically changes the print product",

as claimed in claim 1.

In reply: Regarding claim 1: Okimoto '926 does not explicitly show <u>wherein said print product includes a single paper sheet or a plurality of paper sheets, on each of which an image is already formed through a whole image forming process based on said image data, and said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product</u>.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Tamai '204. In particular, Tamai '204 teaches <u>wherein said print product includes a single paper sheet or a plurality of paper sheets</u> (i.e., a linked document composed of plural kinds of images and printing sheets; Page 1, paragraph [0013]), <u>on each of which an image is already formed through a whole image forming process based on said image data</u> (i.e., the defined image-processing is performed onto the image jobs during the linkage; Page 5, paragraph [0089], figs. 10-12), <u>and said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed</u> (i.e., the post-processing apparatus 36 performs a stapling process, a punching process, or the like onto the printed sheets; Page 3, paragraph [0059], fig. 9c), <u>so as to physically change an appearance and/or a binding mode of said print product</u> (i.e., in S4022, the input of the order of linking the image jobs is processed. At the same time, the screen P4 changes into a screen P5 for selecting a post-process mode as shown in FIG. 9(c); Page 4, paragraph [0082], and figs. 9a-9d).

### *Claim Rejections - 35 USC § 103*

5.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains.  Patentability shall not be negatived by the manner in which the
> invention was made.

6.    Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Okimoto et al. (US 6,268,926) in view of Tamai et al. (US 2002/0061204).

Regarding claim 1, Okimoto '926 discloses an apparatus (4, fig. 3) that

receives an electronic mail (i.e., the apparatus that the print mail reception utility

31b is for receiving electronic mail; Col. 9, lines 5-6), <u>and creates</u> a print product

<u>based on image data included in </u>said electronic mail (i.e., the print mail reception

utility 31b prints the print data included in the file attached to the print mail if

needed, and also prints the contents of the ordinary mail, that is, the message

included in the ordinary mail and the file attached to the mail; Col. 9, lines 9-15),

said apparatus comprising:

a receiving section (the mail reception system, col. 5, lines 25-35) to

receive said electronic mail including <u>said</u> image data (i.e., print data; col. 7, line

64) and finishing information (i.e., a print pattern defined by one page's worth of

print data so that reduced print patterns defined by more than one pages' worth

of print data can be printed onto one sheet of paper.  It therefore becomes

possible to increase the number of pages of print data to be printed onto one

sheet of paper, such as N to 1 page; Col. 6, lines 64-67, Col. 7, 1-3 and Col. 26,

lines 10-15, fig. 13, S982) representing a post processing to be applied to said

print product created on the basis of said image data (i.e., print information

(processing format data) indicative of how the print data included in the attached

file is desired to be printed at the transfer destination. The print information

includes: file attributes such as a page description language, at which the print

data is described, and the number of sheets, onto which the print data is desired

to be printed; Col. 7, lines 55-65),

an acquiring section (Printer Driver 30, fig. 3) to acquire said image data

(i.e., the printer driver 30 is capable of creating print data, outputting the print

data to the printer 6 to print the print data; see col. 8, lines 58-60) and said

finishing information (i.e., the number of pages of print data to be printed onto

one sheet of paper, such as N to 1 page; Col. 6, lines 64-67, Col. 7, 1-3 and Col.

26, lines 10-15, fig. 13, S982), separately from said electronic mail (POP Server

38, fig. 3);

a finishing information judging section (Print Mail Reception Utility 31b, fig.

3) to determine whether or not said post processing (i.e., the present print mail

reception utility process 31b is executed on the computer system 8 side, the

process of S984 is executed to, judge whether the printer 6 is set to the page

description language, a page description language (PDL) specifies the

arrangement of a printed page through commands from a computer that the

printer carries out, as determined in S982; Col. 22, lines 15-20, and fig. 14),

represented by said finishing information (i.e., it is noted that at least a process

for reducing the size of a print pattern defined or data indicating whether the print

data included in the attached file is representative of a single color image or a full

color image; Col. 6, lines 64-67 and Col. 26, lines 10-15), is provided in said

apparatus itself as an applicable post processing (i.e., a print process setting;

Col. 11, line 65; Col. 12, lines 15-25);

a determining section (Transmission Command CPU 132, fig. 2b) to

determine whether or not said finishing information should be changed (i.e., It is

noted that when the present print mail reception utility process 31b is executed

on the computer system 8 side, the process of S984 is executed to, judge

whether the printer 6 is set to the page description language as determined in

S982; see col. 22, lines 15-20, fig. 14), when said finishing information judging

section determines that said post processing is not provided in said image

forming apparatus itself (NO in S984, fig. 14),

a finish setting establishing section (print mail reception utility process, fig.

3) to establish a set of finish setting representing post processing (i.e., 4 in- 1

finishing information, fig. 15, S995) to be applied to said print product based on a

result made (i.e., page description language describing the subject print data is

converted in S995 so that print data equivalent to four pages before conversion is

reduced to one page of print data; Col. 23, lines 5-10, fig. 15) by said determining

section (a program of a print mail reception utility 31b shown in FIGS. 8-17).

Okimoto '926 does not explicitly show wherein said print product includes

a single paper sheet or a plurality of paper sheets, on each of which an image is

already formed through a whole image forming process based on said image

data, and said post processing is defined as such a physical treatment that is to

be applied to said print product after said whole image forming process is

completed, so as to physically change an appearance and/or a binding mode of

said print product.

However, the above-mentioned claimed limitations are well known in the

art as evidenced by Tamai '204. In particular, Tamai '204 teaches wherein said

print product includes a single paper sheet or a plurality of paper sheets (i.e., a

linked document composed of plural kinds of images and printing sheets; Page 1,

paragraph [0013]), on each of which an image is already formed through a whole

image forming process based on said image data (i.e., the defined image-

processing is performed onto the image jobs during the linkage; Page 5,

paragraph [0089], figs. 10-12), and said post processing is defined as such a

physical treatment that is to be applied to said print product after said whole

image forming process is completed (i.e., the post-processing apparatus 36

performs a stapling process, a punching process, or the like onto the printed

sheets; Page 3, paragraph [0059], fig. 9c), so as to physically change an

appearance and/or a binding mode of said print product (i.e., in S4022, the input

of the order of linking the image jobs is processed. At the same time, the screen

P4 changes into a screen P5 for selecting a post-process mode as shown in fig.

9c; Page 4, paragraph [0082], figs. 9a-9d).

In view of the above, having the system of Okimoto and then given the

well-established teaching of Tamai, it would have been obvious to one having

ordinary skill in the art at the time of the invention was made to modify the

system of Okimoto as taught by Tamai to include: wherein said print product
includes a single paper sheet or a plurality of paper sheets, on each of which an
image is already formed through a whole image forming process based on said
image data, and said post processing is defined as such a physical treatment
that is to be applied to said print product after said whole image forming process
is completed, so as to physically change an appearance and/or a binding mode
of said print product, since Tamai stated on page 1, paragraph [0010] that such a
modification would ensure an image-job linking method capable of easily
preparing a linked document composed of different types of images and printing
sheets without tedious work.

Regarding claim 2, Okimoto '926 discloses the apparatus (4, fig. 3),
wherein said acquiring section (Printer Driver 30, fig. 3) includes an electronic
mail analyzing section (CPU 132, fig. 2b) to analyze said electronic mail so as to
acquire said image data (i.e., the print mail transmission utility 31a is executed by
the CPU 132 when a print mail transmission instruction is issued from the printer
driver 30; Col. 9, lines 1-5) and said finishing information (Printer 6, fig. 3),
separately from said electronic mail (POP Server 38, fig. 3).

Regarding claim 3, Okimoto '926 discloses the apparatus (4, fig. 3), further
comprising:

a post processing content storing section (RAM 133, fig. 2b) to store
content of post processing provided in advance (a RAM 133 for preparing a

storage area for temporarily storing print data to be transmitted to a transfer

destination; Col. 8, lines 27-30) in said apparatus itself (4, fig. 3) as applicable

post processing (a print process setting, col. 11, line 65).


Regarding claim 4, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein, when said finishing information judging section (Print Mail

Reception Utility 31b, fig. 3) determines that said post processing (a print process

setting, col. 11, line 65) is provided in said apparatus itself (4, fig. 3), said finish

setting establishing section (Printer Selecting and Setting Process, fig. 14)

establishes said set of finish setting (S984, fig. 14), according to said finishing

information directly acquired from said electronic mail (Select the Appropriate

Printer for Print Output S987, fig. 14).


Regarding claim 5, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said electronic mail analyzing section includes a finishing

information rule storing section to store a rule with respect to a description of said

finishing information (i.e., the header 50b of the print mail further includes print

information (processing format data) such as an indicative rule of how the print

data included in the attached file is desired to be printed at the transfer

destination; Col. 7, lines 53-60), and analyzes said electronic mail data based on

a content stored in said finishing information rule storing section to acquire said

finishing information, when analyzing said electronic mail (i.e., file attributes such

as a page description language (emulation), at which the print data is described,

and the number of sheets (finishing information), onto which the print data is desired to be printed; Col. 7, lines 62-65).

Regarding claim 6, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said finishing information rule storing section stores a tag description (i.e., the process in S982 may be modified to determine whether the mail header includes processing format data indicating that the print data in the attached file is representative of a full color image; see col. 26, lines 10-20) and said finishing information while correlating them with each other (i.e., the file attributes as print information, included in the mail header include codes indicative of the page description language; Col. 26, lines 5-7).

Regarding claim 7, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

a notifying section to notify a sender of said electronic mail (Return to Sender Specified in S630, fig. 11), when said finishing information judging section determines that said post processing is not provided in said apparatus itself (i.e., if there exists no printer having this function to interpret the page description language as determined in S982 ("no" in S985), then in S988 a message is displayed in the mail log window 52 indicating that the current print mail is unprintable; Col. 22, lines 40-45, and fig. 14, Print Mail is Unprintable S988).

Regarding claim 8, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said notifying section notifies said sender of a fact that said post

processing (Return to Sender Specified in S630, fig. 11), represented by said

finishing information (Printer Selecting and Setting Process, fig. 14), is not

provided in said apparatus itself as said applicable post processing (Indicate in

mail log that print mail is unprintable in S988, fig. 14), and of another applicable

post processing corresponding thereto (Switch printer setting to appropriate

function in S986, fig. 14).

Regarding claim 9, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a notifying section to notify a sender of said electronic mail of content (i.e.,

the program determines in S993, based on the contents of its mail log data (mail

header); see col. 22, lines 53-55, fig. 15) of post processing applicable in said

apparatus itself (i.e., the page description language describing the subject print

data is converted in S995 so that print data equivalent to four pages before

conversion is reduced to one page of print data; Col. 23, lines 8-10, fig. 15).

Regarding claim 10, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said applicable post processing differs depending on a sender of

said electronic mail (i.e., the print mail is transmitted to a receiving end (transfer

destination) as specifically desired by a sender to be printed at the transfer

destination. The cancel mail is transmitted to the receiving end (transfer

destination) of the print mail as instructed by the sender to cancel printing of the

print mail; Col. 7, lines 30-35).

Regarding claim 11, Okimoto '926 discloses the apparatus (4, fig. 3),

further comprising:

an individual-sender finishing content storing section to store identifying

information for an individual-sender and a finishing content, which is allowed for

said individual-sender, while correlating them with each other (i.e., the header

50b of the ordinary mail includes: a message ID identifying that mail; an address

of a mail server (24 or 28) connected to the sender; an address of the transfer

destination; a subject of the mail; and the like; Col. 7, lines 44-49, and fig. 18,

Mail Structure).

Regarding claim 12, Okimoto '926 discloses the apparatus (4, fig. 3),

further comprising:

a sender rejecting section to stop an image-forming operation based on

said image data included in said electronic mail, when an address of a sender

coincides with a rejecting address established in advance (i.e., the cancel mail is

transmitted by the mail server 24 to the Internet 28, along which the cancel mail

is transferred until eventually arriving at the a destination. The computer system

at the destination address will attempt to prevent the printing of the print mail

indicated by the one or more cancel message IDs included in the cancel mail.

The computer system will delete data of the print mail; Col. 14, lines 42-49).

Regarding claim 13, Okimoto '926 discloses the apparatus (4, fig. 3),
further comprising:

a sender restricting section to allow an image-forming operation based on
said image data included in said electronic mail, only when an address of a
sender coincides with an allowed address established in advance (i.e., the
header 50b of the ordinary mail includes: a message ID identifying that mail; an
address of a mail server (24 or 28) connected to the sender; an address of the
transfer destination; a subject of the mail; Col. 7, lines 46-49, and fig. 1).


Regarding claim 14, Okimoto '926 discloses the apparatus (4, fig. 3),
further comprising:

an image-forming section to conduct an image-forming operation based
on said image data (i.e., the process of S983 may be modified to set a printer,
which is capable of interpreting the page description language of the print data
and which is capable printing the color-printing type of the print data, to a function
mode to interpret the page description language of the print data and to print the
print data at the corresponding color-printing type; Col. 26, lines 35-40, and fig.
13).


Regarding claim 15, Okimoto '926 discloses the apparatus (4, fig. 3),
further comprising:

a finishing section to apply said post processing to said print product (i.e.,
the print mail reception utility 31b is for receiving electronic mail addressed to the

apparatus 4 and for executing processing operations in correspondence with the

contents of the mail; Col. 9, lines 5-10);

wherein said finishing section performs said-finish processing (Reduce 4

pages of print data to 1 page in S995) based on said set of finish setting (i.e., a

print process setting; Col. 11, line 65).


### Conclusion

7.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Sekiguchi et al. (US 2002/0146256) discloses Image forming apparatus

and method of controlling the same.

Ohtani (US 6,144,818) discloses Image forming apparatus having a

finishing section including improved stapling function.

Nakatani et al. (US 6,945,715) discloses printing condition setting method

and image forming device.


8.      Any inquiry concerning this communication or earlier communications from

the examiner should be directed to ALLEN H. NGUYEN whose telephone

number is (571)270-1229.  The examiner can normally be reached on M-F from

9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, King Poon can be reached on (571)-272-7440.  The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Allen H Nguyen/
Examiner, Art Unit 2625